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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,296

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Jingwu Z. Zhang

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EXAMINER

EWOLDT, GERALD R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,296	Applicant(s) ZHANG, JINGWU Z.	
	Examiner G. R. Ewoldt, Ph.D.	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19 and 23-36 is/are pending in the application.
- 4a) Of the above claim(s) 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 and 23-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/12/07</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicant's election without traverse of Group X filed 6/04/08, is acknowledged. Note that Group X was X+, i.e., it comprised multiple groups. Applicant further elected a peptide vaccine consisting of SEQ ID NO:4.

Applicant has cancelled all pending Claims except Claim 19. The claims have been replaced with Claims 23-36. Claims 34-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

Claims 19 and 23-33 are under examination.

2. The Title and Abstract are objected to because they do not accurately describe the claimed invention. Correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 28 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, specifically, the claims are nonsensical in that they recite a vaccine that must comprise 8 consecutive amino acids of SEQ ID NO:4, yet SEQ ID NO:4 is just 7 amino acids long. Thus, the metes and bounds of the claims cannot be determined.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 19 and 23-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it is unlikely that the claimed peptides could function as effective vaccines nor is it likely that they could even be bound by antibodies in diagnostic assays as broadly claimed.

The specification disclosure is insufficient to enable one skilled in the art to practice the invention as claimed without an undue amount of experimentation. Undue experimentation must be considered in light of factors including: the breadth of the claims, the nature of the invention, the state of the prior art, the level of one of ordinary skill in the art, the level of predictability of the art, the amount of direction provided by the inventor, the existence of working examples, and the quantity of experimentation needed to make or use the invention, see *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988).

In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) states, "The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art." "The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling" (MPEP 2164.03). The MPEP further states that physiological activity can be considered inherently unpredictable. With these teachings in mind, an enabling disclosure, commensurate in scope with the breadth of the claimed invention, is required.

The peptides of the instant claims are disclosed as being useful as vaccines for the treatment of MS or as diagnostic reagents for the diagnosis of MS. The peptides are claimed only as vaccines. While a complete demonstration of efficacy is not required, some demonstration, or at least sound scientific

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reasoning is required for a finding of enablement. In this instance the specification discloses *only* that, "three CDR3-encoded sequences were detected in a high percentage of MS-derived specimens as opposed to control specimens" (which apparently included SEQ ID NO:4) (Table I). The study encompassed 40 MS specimens and 15 controls (pages 23-24). Curiously, it is not disclosed what the "high percentage" actually was. Further regarding the vaccines, to function in that capacity would require that the peptides be bound and presented by MHC Class II (which would then, presumably, activate regulatory T cells). Applicant's own work, Godkins et al. (2001), teaches that the minimum length of a peptide for MHC Class II binding is 12 amino acids (see particularly the first sentence of the Abstract). Thus, Applicant's own work teaches that peptides of 4 to 11 amino acids in length cannot function as vaccines. And as the specification provides *no* data regarding peptide vaccines, it cannot be considered to be enabling of the vaccines in view of the teachings of the prior art. Even regarding the unclaimed use of the peptides as diagnostic agents, it is unlikely that peptides as short as just 4-8 amino acids could even be recognized and bound by antibodies.

For these reasons the products of the instant claims would require undue experimentation to be used as claimed.

7. Claims 25-28 and 30-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter written description rejection.

The specification and the claims as originally filed do not provide support for the invention as now claimed, specifically, the peptides/vaccines of the claims.

Applicant cites paragraphs 31-32 and Table 1 of the specification in support of the claimed invention.

A review of the specification shows that the peptides at paragraph 31 are 4 to 12 amino acids in length and the peptide at Table 1 is 7 amino acids in length.

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 24, 25, 29, and 30 are rejected under 35 U.S.C. 102(a and e) as being clearly anticipated by WO 01/42277 (2001).

WO 01/42277 teaches a peptide of between 4 and 20 amino acids in length comprising 5 consecutive amino acids of SEQ ID NO:4 (see particularly SEQ ID NO:885). Note that for art purposes the vaccine is considered to comprise the peptide.

The reference clearly anticipates the claimed invention.

10. No claim is allowed.

11. As a formal matter, Applicant appears to be prosecuting applications under the names of Jingwu Zhang and Jingwu Zang. Applicant is requested to explain and clarify this issue.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571) 272-0843. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen O'Hara, Ph.D. can be reached on (571) 272-0878.

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13. **Please Note:** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

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